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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,213	04/17/2001	Theodore S. Voltmer	40655.3600	6105
66170 7590 07/16/2007 AMERICAN EXPRESS TRAVEL RELATED SERVICES CO., INC. c/o SNELL & WILMER, L.L.P. ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202			EXAMINER ALVAREZ, RAQUEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 07/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/836,213	Applicant(s) VOLTMER ET AL.	
	Examiner Raquel Alvarez	Art Unit 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. This office action is in response to communication filed on 4/27/07.
2. Claims 1-67 are presented for examination.

#### **Claim Rejections - 35 USC § 102**

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-56, 58, 60, 62, 64-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Deaton et al. (6,292, 786 hereinafter Deaton).

With respect to claims 1-2, 10-12, 14-16, 24-26, 28, 55, 64-66, Deaton teaches receiving and storing manufacture item identifiers wherein said manufacturer item identifiers are received from a manufacturer (i.e. UPC are received from manufacturers 16 and stored at UPC server 12); receiving and processing a consumer ID (col. 17, lines 22-28); receiving and processing purchase data, wherein said purchase data comprises a retail item identifier (col. 17, lines 22-28); associating said consumer ID, said purchase

Art Unit: 3622

data, and a manufacturer item identifier (col. 4, lines 50-60); performing an analysis that is dependent upon the step of associating said consumer ID, said purchased data, and said manufacturer item identifier (col. 4, lines 50-60).

With respect to claims 3-9, 17-23, 29-36, 38, 39, 40-49, 51-54, 67, Deaton further teaches performing an analysis comprises calculating reward points and presenting the award to the consumer in real-time at a point-of sale (col. 7, lines 60-65, col. 8, lines 13-22 and col. 11, lines 11-29).

With respect to claims 13, 27, 37, 50, Deaton further teaches wherein said payment vehicle comprises credit card, check, debit card (col. 4, lines 29-31).

With respect to claims 56, 58, 60, and 62, Deaton teaches receiving and storing manufacturer item identifiers (col. 17, lines 22-28); allocating reward points to at least one of a manufacturer and a retailer (col. 15, lines 33-44); receiving and processing a consumer ID (col. 17, lines 22-28); receiving and processing purchase data, wherein said purchase data comprises a retail item identifier (col. 17, lines 22-28); issuing, by at least one of said retailer and said manufacturer, reward points to consumer (col. 15, lines 33-44); redeeming said reward points for a consumer (col. 7, lines 18-22); associating said consumer ID, said purchase data, and a manufacturer item identifier (col. 4, lines 50-60); performing an analysis that is dependent upon the step of

Art Unit: 3622

associating said consumer ID, said purchased data, and said manufacturer item identifier (col. 4, lines 50-60).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 57, 59, 61 and 63 rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (6,292, 786 hereinafter Deaton).

Claims 57, 59, 61 and 63 further recite redeeming the reward through a universal rewards catalog. Deaton teaches redeeming the reward, the reward being for different manufacturers and stores (col. 7, lines 18-22 and Figure 1). Deaton does not specifically teach using a universal reward catalog. Universal catalogs are old and well known in which like products from different suppliers have a single database record. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a universal reward catalog to redeem the reward of Deaton because such a modification would allow the customer to redeem his reward from one single source and therefore save the customer time.

**Response to Arguments**

5. Applicant argues Deaton doesn't teach a system which receives and stores UPC codes from various manufacturers. The Examiner disagrees with Applicant because in Deaton UPC server 12 receives and stores in memory 64 or storage device 62, UPC codes received from manufacturers 16. When the customer purchases a product, the POS sends the UPC code to UPC server 12 which identifies the manufacturer from the plurality of manufacturers 1-N based on the UPC code received and therefore based on the identification of the manufacturers it discounts the products or communicates with the manufacturers through communication link 26. Therefore, contrary to Applicant arguments, Deaton clearly teaches a plurality of manufactures 1-N.

**Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

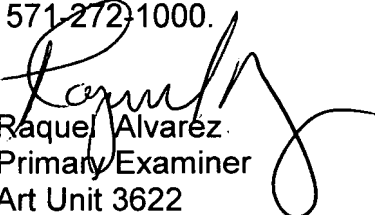
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
6/25/2007